

Appl. No. 10/759,505
Amdt dated April 26, 2007
Reply to Office Action of October 30, 2006
Att. Docket No.: 1279-400C1

Filing date: January 16, 2004
Applicant Name: Bazan et al.
Examiner: Camie S. Thompson
Art Unit: 1774

REMARKS/ARGUMENTS

Claims 4-5, 12-15, 18 and 19 are pending.

New claims 20-22 have been added. Support for these claims can be found from compounds disclosed on page 6 of the specification, and from claims 4 and 15.

The rejection of claims 4-5, 12-15 and 18-19 under 35 U.S.C. 102(e) as being anticipated by Toguchi et al. (U.S. Patent Number 6,582,837) is respectfully traversed. Applicants' claims are directed to formula's which are not expressly disclosed and/or enabled by Toguchi et al. Applicants' claim 4, 5, 12, 14 is directed to, *inter alia*, a binaphthyl compound where specific substitutions are made at the R¹, R², Ar¹ and Ar² positions; while claims 13, 18 and 19 are directed to, *inter alia*, a binaphthyl compound where specific substitutions are made at the Ar¹ and Ar² positions. In contrast, Toguchi et al. show a generic formula that can be substituted independently at any one of the R₂¹ to R₂¹⁴ with a host of chemical groups, whereby the generic formula encompasses a vast number and perhaps even an infinite number of compounds. However, nowhere in Toguchi et al. is there disclosed substitutions to only R¹, R², Ar¹ and Ar². In addition the preferred embodiments II-3, II-4, and II-5 disclosed by Toguchi (see column 12, lines 60-67; and formulas on columns 13 and 15) also do not disclose Applicants' claims. In this regard refer to MPEP 2131.02, to wit:

"A GENERIC CHEMICAL FORMULA WILL ANTICIPATE A CLAIMED SPECIES COVERED BY THE FORMULA WHEN THE SPECIES CAN BE "AT ONCE ENVISAGED" FROM THE FORMULA

When the compound is not specifically named, but instead it is necessary to select portions of teachings within a reference and combine them, e.g., select various substituents from a list of alternatives given for placement at specific sites on a generic chemical formula to arrive at a specific composition, anticipation can only be found if the classes of substituents are sufficiently limited or well delineated. Ex parte A, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990). If one of ordinary skill in the art is able to "at once envisage" the specific compound within the generic chemical formula, the compound is anticipated. One of ordinary skill in the art must be able to draw the structural formula or write the name of each of the compounds included in the generic formula before any

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of the compounds can be "at once envisaged." One may look to the preferred embodiments to determine which compounds can be anticipated. In re Petering, 301 F.2d 676, 133 USPQ 275 (CCPA 1962).

In In re Petering, the prior art disclosed a generic chemical formula "wherein X, Y, Z, P, and R"- represent either hydrogen or alkyl radicals, R a side chain containing an OH group." The court held that this formula, without more, could not anticipate a claim to 7-methyl-9-[d, l"-ribityl]-isoalloxazine because the generic formula encompassed a vast number and perhaps even an infinite number of compounds. However, the reference also disclosed preferred substituents for X, Y, Z, R, and R" as follows: where X, P, and R" are hydrogen, where Y and Z may be hydrogen or methyl, and where R is one of eight specific isoalloxazines. The court determined that this more limited generic class consisted of about 20 compounds. The limited number of compounds covered by the preferred formula in combination with the fact that the number of substituents was low at each site, the ring positions were limited, and there was a large unchanging structural nucleus, resulted in a finding that the reference sufficiently described "each of the various permutations here involved as fully as if he had drawn each structural formula or had written each name." The claimed compound was 1 of these 20 compounds. Therefore, the reference "described" the claimed compound and the reference anticipated the claims.

In In re Schauman, 572 F.2d 312, 197 USPQ 5 (CCPA 1978), claims to a specific compound were anticipated because the prior art taught a generic formula embracing a limited number of compounds closely related to each other in structure and the properties possessed by the compound class of the prior art was that disclosed for the claimed compound. The broad generic formula seemed to describe an infinite number of compounds but claim 1 was limited to a structure with only one variable substituent R. This substituent was limited to low alkyl radicals. One of ordinary skill in the art would at once envisage the subject matter within claim 1 of the reference.).

Compare In re Meyer, 599 F.2d 1026, 202 USPQ 175 (CCPA 1979) (A reference disclosing "alkaline chlorine or bromine solution" embraces a large number of species and cannot be said to anticipate claims to "alkali metal hypochlorite."); Akzo N.V. v.

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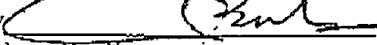
International Trade Comm'n, 808 F.2d 1471, 1 USPQ2d 1241 (Fed. Cir. 1986) (Claims to a process for making aramid fibers using a 98% solution of sulfuric acid were not anticipated by a reference which disclosed using sulfuric acid solution but which did not disclose using a 98% concentrated sulfuric acid solution.). See MPEP § 2144.08 for a discussion of obviousness in genus-species situations."

Accordingly, applicants' claims are not anticipated by Toguichi et al. and these rejections should be withdrawn.

In view of the foregoing, applicant believes that the application is in condition for allowance and respectively solicits a Notice of Allowance. The Commissioner is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 50-3881.

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Respectfully submitted,

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